

ESTTA Tracking number: **ESTTA415386**

Filing date: **06/20/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	77754249
Applicant	William Tatham
Applied for Mark	GRAND PRIX SPORTS
Correspondence Address	Scott W. Kelley KELLY LOWRY & KELLEY, LLP Suite 16506320 Canoga Avenue Woodland Hills, CA 91367 UNITED STATES scott@KLKPatentLaw.com
Submission	Appeal Brief
Attachments	52228_Appeal_Brief.pdf (14 pages)(184225 bytes)
Filer's Name	Scott W. Kelley
Filer's e-mail	scott@KLKPatentLaw.com
Signature	/Scott W. Kelley/
Date	06/20/2011

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	William Tatham)
)
Serial No.:	77/754,249)
)
Filed:	June 8, 2009)
)
Mark:	GRAND PRIX SPORTS)
)
Int. Classes:	041)
)
Our Docket:	TATHAM-52228)
)

Commissioner of Trademarks
Trademark Trial and Appeal Board
VIA EFILE

BRIEF BY APPELLANT/APPLICANT

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	2
II. ISSUES FOR REVIEW	2
III. STATEMENT OF THE CASE/Procedural History -and- Factual Background.....	2
IV. ARGUMENTS – APPLICANT’S GRAND PRIX SPORTS MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT’S SERVICES BECAUSE IT DOES NOT IMMEDIATELY DESCRIBE THE SERVICES, A LEVEL OF IMAGINATION IS REQUIRED TO ASSOCIATE THE MARK WITH THE SERVICES AND THE MARK INCLUDES SECONDARY MEANING	4
1. Applicant’s Applied-For Mark Does Not Immediately Describe the Applicant’s Services	5
2. A Level of Imagination, Thought or Perception is Required to Associate GRAND PRIX SPORTS with Applicant’s Services	8
3. The GRAND PRIX SPORTS Mark Conveys Secondary Meaning Regarding a Prestige of Services	9
4. Case Law Cited by the Examining Attorney Actually Favors Registering the Applicant’s Applied-For Mark	10
V. CONCLUSION.....	12

* * * * *

TABLE OF CASES

<u>CASES</u>	<u>Page</u>
In re Gyulay, 820 F.2d 1216 (Fed. Cir. 1987)	5
In re Abcor Development Corp., 200 USPQ 215, 217-8 (CCPA 1978)	5
In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986).....	5
In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978).....	5
In re Chopper Industries, 222 USPQ 258 (TTAB 1984)	6
In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979)	6
In re Champion International Corp., 183 USPQ 318 (TTAB 1974)	6
In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968)	8
In re Shutts, 217 USPQ 363 (TTAB 1983).....	8
In re Kinston Office Supply Co., S.N. 75/438,489 (January 24, 2001).....	9
In re Oppendahl & Larson LLP, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004).....	10

BRIEF OF APPELLANT/APPLICANT

I. INTRODUCTION

This is the opening brief of Applicant William Tatham requesting that the TTAB reverse the Trademark Examining Attorney's final refusal under Section 2(e)(1) to register its applied-for mark GRAND PRIX SPORTS on grounds that it, "merely describes a feature of applicant's services."

II. ISSUES FOR REVIEW

A. Whether the Examining Attorney's decision to refuse registration of Applicant's mark GRAND PRIX SPORTS was incorrect and should be reversed.

B. More specifically, whether, the Examining Attorney's determination that the applied-for GRAND PRIX SPORTS mark is merely descriptive of a feature of Applicant's services, namely, organizing sports league events, namely, rugby and soccer tournaments.

III. STATEMENT OF THE CASE/Procedural History -and- Factual Background

Applicant William Tatham filed the subject U.S. App. Serial No. 77/754,249 on June 8, 2009 based upon a bona fide intent-to-use the applied-for mark in commerce, requesting registration on the Principal Register of GRAND PRIX SPORTS. The applied-for GRAND PRIX SPORTS mark is contemplated to be used for organizing sports league events, namely, rugby and soccer tournaments.

The Examining Attorney's first Office Action, mailed September 9, 2009, provisionally refused registration on the basis that, "the applied-for mark merely describes a feature of applicant's services." The first Office Action also requested that the applicant submit a specimen showing use of the applied-for mark in commerce for the services identified in the application; amend the identification of services; list the goods/services by international class and submit additional filing fees and submit a specimen showing the mark in use in commerce for each class of goods and/or services; disclaim "SPORTS" apart from the mark as shown; and provide the dates of first use of the mark.

The Applicant electronically submitted its response on March 9, 2010 providing amendments to the descriptions of services, disclaiming the word "SPORTS", changing the filing basis from Section 1(a) to Section 1(b) (intent-to-use), and providing arguments against the finding that the applied-for mark is merely descriptive of the Applicant's services.

In Applicant's response to the first Office Action, Applicant argued that the applied-for mark GRAND PRIX SPORTS does not immediately describe an ingredient, quality, characteristic, function, feature, purpose of use of the specified goods or services, and is therefore registerable on the Principal Register.

The Examining Attorney's second Office Action, mailed April 12, 2010 continued the refusal under Section 2(e), and further stated that "Applicant's response was unclear with respect to the precise nature of the services" and, accordingly, raised additional questions. The Examining Attorney asked Applicant to provide additional information about the identified services and to answer specific questions concerning the nature of the identified services.

The Applicant electronically submitted its second response on September 29, 2010, providing a detailed description of Applicant's services and responses to the Examining Attorney's questions.

The Examining Attorney's third Office Action, mailed October 28, 2010, made his refusal under Section 2(e)(1) "final." That Office Action indicated that "GRAND PRIX" is defined as follows: high level or important sporting competitions. Registration was refused because high level sporting competitions are a significant feature of the identified services.

The Applicant submitted a Notice of Appeal to the TTAB on April 25, 2011. This brief is in now filed in accordance with the Notice of Appeal.

IV. ARGUMENTS – APPLICANT'S GRAND PRIX SPORTS MARK IS NOT MERELY DESCRIPTIVE OF APPLICANT'S SERVICES BECAUSE IT DOES NOT IMMEDIATELY DESCRIBE THE SERVICES, A LEVEL OF IMAGINATION IS REQUIRED TO ASSOCIATE THE MARK WITH THE SERVICES AND THE MARK INCLUDES SECONDARY MEANING.

Applicant submits that the applied-for GRAND PRIX SPORTS mark is not merely descriptive of the Applicant's services. First, a mark is not merely descriptive unless it immediately described the goods or services. Second, a level of imagination, thought or perception is required to associate GRAND PRIX SPORTS with the Applicant's services. Finally, the Applicant's mark is registrable because a secondary meaning regarding a prestige of services is conveyed in GRAND PRIX SPORTS. Therefore, in view of the discussion of law and facts below, Applicant's GRAND PRIX SPORTS mark is not merely descriptive of the

Applicant's services and it is therefore respectfully requested that the TTAB reverse the Examining Attorney's decision and direct the subject application for GRAND PRIX SPORTS in international class 041 be advanced to publication.

1. Applicant's Applied-For Mark Does Not Immediately Describe the Applicant's Services and is Therefore Registrable on the Principle Register

A mark is not merely descriptive under Section 2(e)(1) of the Trademark Act unless it immediately "describes an ingredient, quality, characteristic, function, feature, purpose of use of the specified goods or services." See *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 200 USPQ 215, 217-8 (CCPA 1978); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). More specifically, the CAFC in *Gyulay* stated, "[w]hether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used', or whether 'imagination, thought, or perception is required to reach a conclusion on the nature of the goods'." The immediate idea must be conveyed with a "degree of particularity." *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978). If some exercise of imagination, thought, or perception is required to reach a conclusion as to the nature of the goods or services, the mark is at best suggestive and not merely descriptive, and is thus registrable on the Principal Register without proof of secondary meaning.

The Applicant's services are organizing sports league events, namely, rugby and soccer tournaments. The Examining Attorney stated that GRAND PRIX refers to "high level and/or important sporting competitions." However, this is not the primary definition of GRAND PRIX

according to the evidence presented by the Examining Attorney (See Examiner Attachments 1-19) and therefore, in accordance with TMEP 1209.03(e), the supplemental meaning is not controlling. TMEP § 1209.03(e) states: “Descriptiveness must be determined in relation to the goods or services for which registration is sought. Therefore, the fact that a term may have a different meaning(s) in a different context is not controlling. See *In re Chopper Industries*, 222 USPQ 258 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); *In re Champion International Corp.*, 183 USPQ 318 (TTAB 1974).” According to the Examining Attorney’s evidence, the primary definition of GRAND PRIX means a car race. (See Examiner Attachments 1-19) According to www.Encarta.MSN.com the primary definition of GRAND PRIX is an “Important car race: any of a number of important international annual races for racecars, held to decide the world automobile-racing championship.” According to www.Merriam-Webster.com the primary definition of GRAND PRIX is “the highest level of international equestrian competition” and then the secondary definition is “one of a series of international formula car races.” According to www.YourDictionary.com the primary definition of GRAND PRIX is “any of a series of races involving formula cars and leading to an overall championship.” According to www.TheFreeDictionary.com the primary definition of GRAND PRIX is “one of several international races.” In the Examining Attorney’s cited references, the definition of GRAND PRIX as a sporting competition, particularly relating to rugby and soccer, was either not mentioned or mentioned as a secondary meaning. In summary, the dictionary definitions cited by the Examining Attorney show GRAND PRIX is defined primarily as a car race.

A mark is not merely descriptive under Section 2(e)(1) of the Trademark Act unless it immediately “describes an ingredient, quality, characteristic, function, feature, purpose of use of the specified goods or services.” See *In re Gyulay*, 820 F.2d 1216 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 200 USPQ 215, 217-8 (CCPA 1978); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). More specifically, the CAFC in *Gyulay* stated, “[w]hether a given mark is suggestive or merely descriptive depends on whether the mark ‘immediately conveys . . . knowledge of the ingredients, qualities, or characteristics of the goods . . . with which it is used’, or whether ‘imagination, thought, or perception is required to reach a conclusion on the nature of the goods’.” The immediate idea must be conveyed with a “degree of particularity.” *In re TMS Corporation of the Americas*, 200 USPQ 57, 59 (TTAB 1978). If some exercise of imagination, thought, or perception is required to reach a conclusion as to the nature of the goods or services, the mark is at best suggestive and not merely descriptive, and is thus registrable on the Principal Register without proof of secondary meaning. A consumer in attendance at an entertainment property of the Applicant would have to do some thought and imagination to combine the meaning of GRAND PRIX (being “car racing”) with the meaning of SPORTS (being “activities for exercise”) to associate the GRAND PRIX SPORTS trademark with the various sports content, league, and/or tournament the consumer was engaged in. Associating “car racing” and “activities for exercises” does not immediately convey knowledge of the ingredients, qualities, or characteristics of the goods. Accordingly, GRAND PRIX SPORTS is not merely descriptive, as GRAND PRIX SPORTS requires a level of imagination, thought, and/or perception to associate “car racing” and “activities for exercise” as then being for the services of “organizing sports league events, namely rugby and soccer tournaments.”

Furthermore, TMEP § 1209.03(d) states: “When two descriptive terms are combined, the determination of whether the composite mark also has a descriptive significance turns upon the question of whether the combination of terms evokes a new and unique commercial impression . . . However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. See *In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (C.C.P.A. 1968) (SUGAR & SPICE held not merely descriptive of bakery products); *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool).” Applying this standard to the present application, the combination of GRAND PRIX SPORTS creates a unique and nondescriptive meaning for organizing sports league events, namely, rugby and soccer. GRAND PRIX refers to car races. As cited by the Examining Attorney according to www.TheFreeDictionary.com, SPORTS refers to “an activity for exercise, pleasure, or competition.” The combination of “car races” and “activities for exercise” are clearly not merely descriptive of “organizing sports league events, namely, rugby and soccer.”

2. A Level of Imagination, Thought or Perception is Required to Associate GRAND PRIX SPORTS with Applicant’s Services

Even if a consumer could extrapolate some meaning out of Applicant’s mark with respect to describing the services performed by Applicant, such extrapolation requires some imagination, thought or perception to reach a conclusion as to the nature of the associated services. For example, a consumer would need to set aside any reference to the racing competition itself, to

acquire any relevant association with Applicant's services. There is simply no evidence on the record that a consumer would do so. Even if they did, extrapolation of such meaning makes the mark suggestive at most, not merely descriptive. See TMEP §1209.01(a). Suggestive marks are "inherently distinctive" and are immediately "registrable on the Principal Register without proof of acquired distinctiveness" under Section 2(f). *Id.* Hence, suggestive marks do not have to be devoid of all meaning in relation to the goods and/or services to be registrable on the Principal Register. See *In re Shutts*, 217 USPQ 363 (TTAB 1983) (SNO-RAKE held not merely descriptive of a snow removal hand tool); TMEP §1209.01(a). A consumer would have to do some level of thought and imagination to combine the meaning of GRAND PRIX with the meaning of SPORTS to associate the GRAND PRIX SPORTS mark with the organizing of sports league events, namely rugby and soccer tournaments. Accordingly, GRAND PRIX SPORTS is not merely descriptive, as GRAND PRIX SPORTS requires a level of imagination, thought, and/or perception to associate GRAND PRIX and SPORTS as then being the organizing of sports league events, namely rugby and soccer tournaments.

3. The GRAND PRIX SPORTS Mark Conveys Secondary Meaning Regarding a Prestige of Services and is Therefore Registrable on the Principle Register

A similar case to the present application is very informative to better understand why GRAND PRIX SPORTS is not merely descriptive. In *In re Kinston Office Supply Co.*, S.N. 75/438,489 (January 24, 2001), the Board reversed a Section 2(e)(1) refusal to register, concluding that the mark CORPORATE RESOURCES is not merely descriptive for "retail store services in the area of office supplies and equipment." Even if the designation "corporate

resources” includes the office equipment and supplies utilized by a corporation, the term is commonly used to connote a corporation’s assets for increasing its production or profit, including its office facilities, human capital, and raw materials. Because of this double entendre, the mark is at most suggestive of Applicant’s services. It conveys “an air of importance or aggrandizement to such everyday or mundane products as office supplies and equipment,” thus creating a new and different commercial impression when used in the context of Applicant’s retail store services. Similarly, the secondary meaning of GRAND PRIX conveys an air of importance or aggrandizement to SPORTS that makes the mark of GRAND PRIX SPORTS not merely descriptive. According to the Examining Attorney’s reference of www.Encarta.MSN.com, the secondary meaning of GRAND PRIX is “any of various competitions in a variety of sports that have the same importance and prestige as a Grand Prix in automobile racing.” The mark of GRAND PRIX SPORTS conveys an air of importance or aggrandizement from the GRAND PRIX portion to the SPORTS portion which requires the consumer to have a level of imagination, thought and perception. Accordingly, GRAND PRIX SPORTS is not merely descriptive of organizing sports league events, namely, rugby and soccer tournaments.

4. Case Law Cited by the Examining Attorney Actually Favors Registering the Applicant’s Mark

The Examining Attorney purports to cite in support of the rejection to register the Applicant’s applied-for mark the case of *In re Oppendahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). However, a fair reading of the case suggests the

Applicant's applied-for mark is actually registrable on the Principle Register. In *In re Oppendahl & Larson LLP*, the Federal Circuit affirmed the refusal to register the mark PATENTS.COM for software that tracked patents and trademarks. The ".COM" portion of the mark was found to be a top level domain (TLD) indicator without any trademark significance. The court held that software which tracked the status of "patents" is seminal to the applied-for mark of PATENTS.COM. This is not an analogous situation to the instant application. In the instant application, the Applicant's applied-for mark consists of three words (GRAND, PRIX and SPORTS) each of which holds a level of trademark significance.

The Federal Circuit cautioned that, "[d]escriptive marks can qualify for registration on the Principal Register if they acquire secondary meaning, i.e., distinctiveness." See *Id* at 1173. The court then proposes the hypothetical case where TENNIS.NET could be registrable due to a double entendre. "The hypothetical mark as a whole, as is immediately apparent, produces a witty double entendre relating to tennis nets, the hypothetical applicant's product...This hypothetical example illustrates that, although TLDs will most often not add any significant source-identifying function to a mark, a bright-line rule might foreclose registration to a mark with a TLD component that can demonstrate distinctiveness." *Id* at 1175. This situation is similar to the Applicant's applied for mark of GRAND PRIX SPORTS, where the secondary meaning of GRAND PRIX conveys an air of importance or aggrandizement to SPORTS that makes the mark of GRAND PRIX SPORTS not merely descriptive.

In the examples provided by the Examining Attorney, the applied-for mark and the services were exactly the same in all major respects. This is not the case of the Applicant's applied-for mark where it would be a rare, but possible, occurrence when the Applicant's

services would cover a grand prix racing event. In view of the differences between the present application and the purported cited authority by the Examining Attorney, the refusal to register the applied-for mark of GRAND PRIX SPORTS should be removed and allowed registration on the Principal Register.

V. CONCLUSION

In view of the discussion of law and facts above, Applicant's GRAND PRIX SPORTS mark is not merely descriptive of the Applicant's services and it is therefore respectfully requested that the TTAB reverse the Examining Attorney's decision and direct the subject application for GRAND PRIX SPORTS in international class 041 be advanced to publication.

Dated: June 20, 2011

Respectfully submitted,

/Scott W. Kelley/

Scott W. Kelley
KELLY LOWRY & KELLEY, LLP
6320 Canoga Avenue, Suite 1650
Woodland Hills, CA 91367
(818) 347-7900 / Fax: (818) 340-2859
Scott@KLKPatentLaw.com

SWK:/jc